

Attorneys for Opposer  
*Mandarin Music Pty Ltd.*

## INTRODUCTION

On March 8, 1999, Applicant filed an application to register, on an "intent-to-use" basis, the name of his musical group, TAKSI RIDER, as a trademark for "compact discs, cassette tapes, and other sound recording devices" and as a service mark for "production, manufacturing, and distribution of compact discs, cassette tapes and other sound recording devices" (the Services"). Acknowledging that he never had a bona fide intent to use the mark in connection with the Services, Applicant later amended his application to delete the Services. Applicant also amended the goods in his application to read "Prerecorded compact discs, audio cassettes and audio tapes all featuring music and other sound recording devices, namely, audio discs, video discs, and video cassettes all featuring music" (the "Goods"). As the evidence shows, Applicant does not have, and never had, a bona fide intent to use his band name "Taksi Rider" as a trademark for such Goods.

## STATEMENT OF FACTS

Applicant is a resident of Toronto, Canada and is member and founder of the musical group "Taksi Rider." (Applicant's Application Serial No. 75-655,561 (the "Application"); Colbourne Tr., 5:1-5; 5:20-24). In August, 1999, Applicant hired the services of RDR Promotions to manufacture Taksi Rider's sole recording, entitled "Sightings." (Colbourne Tr., 4:13-5:19; Brill Tr., 4:3-6, Ex. 1). Applicant ordered from RDR Promotions 550 compact discs *and no audio cassettes* of the "Sightings" recording. (Colbourne Tr., 7:14-17). The recording label under which the recording was issued, the name of which appears on the cover of the compact disc, is "Revent Records." (Brill Tr., 4:3-6, Ex. 1). "Taksi Rider" is used on the recording only as the name of the musical group, and not as a trademark for sound recordings.

Apart from the "Sightings" compact disc, Applicant never released any other musical recordings of the musical group Taksi Rider. (*Id.*, 6:16-19; Brill Tr., 4:22-25; Opposer's Notice of Reliance ("ONR"), Ex. A). The only retail store that appears to have offered the "Sightings" CD in 1999 was the HMV Music store at 333 Yonge Street in Toronto, and it offered only two (2) copies of the CD on consignment. (Colbourne Tr., 4:1-12; Brill Tr., 4:3-6, Ex. 1). In fact, Applicant's single recording "Sightings" is not even available through the retail web sites

Amazon.com and CDNow.com. (ONR, Ex. A). As of July 15, 2002, the HMV Music store in Toronto, Applicant's home town, no longer carries "Sightings," nor did several of the other prominent record stores in the Toronto area. (Brill Tr., 4:7-21). There is no evidence that Applicant ever used the name TAKSI RIDER for any business of producing, manufacturing or distributing musical recordings. (*Id.*, 6:4-7).

### ARGUMENT

Contrary to Applicant's representation that he has "[used] the trademark for goods listed in the amended application" (Applicant's Answer, ¶ 2), Applicant uses "Taksi Rider" solely as the name of his musical group, and *not* as a trademark for the Goods. The name of a recording group can be a valid trademark for musical recordings only if "the name of that recording group has been used numerous times on different records and has therefore come to represent an assurance of quality to the public." *In re Polar Music*, 221 U.S.P.Q. 315, 318 (Fed. Cir. 1983); *In re Spirer*, 225 U.S.P.Q. 693, 694 (T.T.A.B. 1985) (quoting *In re Polar Music* for same proposition).

Use in commerce is defined as "bona fide use of a mark in the ordinary course of trade." 15 U.S.C. § 1127. Because Applicant made only a single recording with the Taksi Rider group in 1999, which was sold on consignment in one retail outlet in Toronto, Canada, and there is no evidence that Applicant has made or is planning any subsequent recording of the band Taksi Rider, Applicant did not and does not have the requisite bona fide intention "under circumstances showing... good faith... to use [the] trademark in commerce." 15 U.S.C. § 1051(b)(1).

Further, the evidence that Taksi Rider's sole musical recording was printed by a local manufacturer (only 550 copies in the first print) *on compact disc only* demonstrates that Applicant never intended to offer audio cassettes, audio tapes, video discs or video cassettes of TAKSI RIDER, all of which are listed among the Goods in the Application. Given that the "Sightings" recording, which was released approximately four years ago, is no longer available in Toronto stores and is not even available on Internet web sites such as Amazon.com and

CDNow.com, Applicant cannot legitimately claim that he intends to offer the "Sightings" recording in these alternative formats in the near future, let alone *multiple* recordings as is required by U.S. trademark law to show trademark rights in a group name for the group's musical recordings. *Id.* Thus, Applicant cannot be said to have had (or to now have) a bona fide intent to use the mark TAKSI RIDER as a trademark for audio cassettes, audio tapes, video discs or video cassettes under Section 44(d) of the Lanham Act, and the Application should be denied. 15 U.S.C. § 1126(d).

Finally, as evidenced by Applicant's failure to use the TAKSI RIDER mark in connection with any of the Services, and his amendment of the Application to delete the Services, when Applicant filed the Application on March 8, 1999, Applicant misrepresented to the Patent and Trademark Office his intent to use the mark in connection with the Services alleged in the Application. Such misrepresentation of Applicant's true intent is in and of itself basis to deny the Application in its entirety. *See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1507 (T.T.A.B. 1993) (recognizing that an "intent to use" application may be denied if the Applicant lacked a good faith intent to use in connection with all of the goods and services in the application); *see also Medinol Ltd. v. Neuro Vaxx, Inc.*, 2003 TTAB LEXIS 227, \*12 (T.T.A.B. 2003) ("[i]f fraud can be shown in the procurement of a registration, the entire resulting registration is void").

In view of the foregoing, Opposer respectfully request's that Application Serial No.

75/655,561 be denied.

Dated: New York, NY  
March 15, 2004

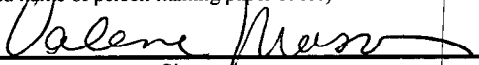
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Date of Deposit: March 15, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office, to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

VALERIE MASON

(Printed name of person mailing paper of fee)

  
Signature

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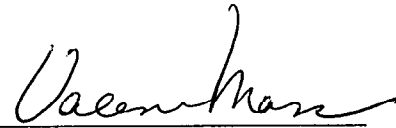
  
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**CERTIFICATE OF SERVICE**

The undersigned, counsel for Mandarin Music Pty Ltd., hereby certifies under penalty of perjury that I caused a true and correct copy of the attached BRIEF FOR OPPOSER to be sent by "Federal Express" on March 15, 2004 to Joseph Greenbaum, 50 Stephanie Street, Suite 1110, Toronto, Ontario, Canada, M5T 1B3.



Valerie Mason